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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,629	02/06/2001	Yoshio Sugimoto	1046.1238 (JDH)	7168
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER BARQADLE, YASIN M	
			ART UNIT 2153	PAPER NUMBER
			MAIL DATE 07/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/776,629

Applicant(s)

SUGIMOTO, YOSHIO

Examiner

Yasin M. Barqadle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The amendment filed on April 16, 2007 has been fully considered but are not deemed persuasive.

- Claims 1-21 are presented for examination.

Response to Amendment

Applicant argues, "that Bailey does not teach "upon a reading of one of the electronic mails after the predetermined timing the state of "unread" being not change." (page 7, second paragraph). Applicant also argues that Bailey teaches away from the present invention" (page 7, paragraph 6). Examiner notes that Bailey teaches a heuristic method of marking read messages as read and if the heuristic method is not met the flag remains FALSE. But also Bailey teaches displaying message in preview pane (70 Mark_AS_READ = FALSE (72), set timer (74), has user marked as unread (86), Yes, then MARK_AS_READ = FALSE (see the steps in fig. 5 and col. 5; lines 61-65). Alternatively, the unread message remains unread by overwriting the heuristic.

Furthermore, Bailey teaches if the displayed message does not fit in the preview pane entirely (such as partial display of the message step 82) the flag remains FALSE (the state remains unread) (col. 5, lines 54-60). Bailey does not teach away from

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the present invention. Bailey, simply shows another way of solving the problem.

Regarding the letter dated April 16, 2007 requesting an Interview, the examiner is not aware of any telephone discussion between the Applicant's representative and the Examiner requesting for an Interview. Also, the examiner did not notice the written request for an interview until later date. However, the Examiner is ready to grant an interview to the Applicant's representative at any time upon calling the examiner and negotiating for a date and time that is a convenient for everyone.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do

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not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-6, 8-13 and 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailey et al USPN (5835084).

As per claim 1, Bailey et al teach a device for reading electronic mails (device 10, fig. 2), comprising:

a storing unit storing unread/already-read information corresponding to each of received electronic mails [storage 34, stores received unread email messages addressed (received) to a user col. 3, lines 60-67 and col. 4, lines 33-56];

a managing module creating a list of each electronic mail having an "unread" state based on the unread/already-read information at a predetermined timing (a list of unread messages are displayed visually different than the read messages (abstract), and upon reading one of the electronic mails after a predetermined timing [window pane hold a list of unread/already-read message. Email messages are organized and mark as read or

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unread col. 3, lines 60-67; col. 4, lines 45-52 and col. 5, lines 10-32], the state of "unread" being not changed (a timer is set for a selected time-out period and if the entire message is not displayed keeping the flag false col. 5, lines 54-65 and col. 6, lines 21-38); and

a controller controlling a management of reading of the electronic mail with the state of "unread" on the list [a processor executes a method for distinguishing between read and unread messages col. 5, lines 15-38 and col. 6, lines 21-38].

As per claim 2, Bailey et al teach the device according to claim 1, wherein said storing unit stores the state of "unread" or a state of "already-read" of a corresponding electronic mail as the unread/already-read information [col. 5, lines 10-23]; and

said controller executes a process for displaying a registered electronic mail in said list on a display according to a request for reading the registered electronic mail [col. 3, lines 60 to col. 4, line 56 and col. 5, lines 1-14].

As per claim 3, Bailey et al teach the device according to claim 2, wherein said controller specifies the electronic mail with the state of "unread" on the list corresponding to the request

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by use of said list, and displays a body of the specified electronic mail on said display [fig. 4 and col. 5, lines 1-23].

As per claim 4, Bailey et al teach the device according to claim 1, further comprising a display controller displaying a screen for searching the electronic mail with the state of "unread" on the list managed by said managing module on said display [fig. 3; col. 3, lines 60 to col. 4, lines 7 and col. 5, lines 1-23].

As per claim 5, Bailey et al teach the device according to claim 4, wherein said list holds information of the plurality of registered electronic mails in predetermined sort order [fig. 3, col. 4, lines 33-44];

a pointer is set at any one of the information in said list [fig. 3, and col. 4, lines 45-52]; and

said display controller displays the screen for searching an electronic mail registered next to the registered electronic mail corresponding to the information pointed by the pointer and/or a previous electronic mail of the registered electronic mail corresponding to the information pointed by the pointer [fig. 3, and col. 4, lines 45-52 and col. 6, lines 21-26].

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As per claim 6, Bailey et al teach the device according to claim 1, wherein the predetermined timing is a time point of which reading the body of the electronic mail is requested [col. 4, lines 24-65].

As per claims 8 and 15, these are a storage medium and method claims with similar limitations as claim 1 above. Therefore, they are rejected with the same rationale. See the rejection of Claim 1 above.

As per claims 9 and 16, Bailey et al teach the invention wherein said storing stores the state of "unread" or a state "already-read" of a corresponding electronic mail as the unread/already-read information [col. 5, lines 10-32],

said controlling step executes a process for displaying a registered electronic mail in said list on a display according to a request for reading the registered electronic mail [a processor executes a method for distinguishing between read and unread messages col. 5, lines 15-38].

As per claims 10 and 17, Bailey et al teach the invention wherein said controlling specifies the electronic mail with state of "unread" corresponding to the request by use of said

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list, and displays a body of the specified electronic mail on said display [fig. 4 and col. 5, lines 1-23].

As per claims 11 and 18, Bailey et al teach the invention, further comprising displaying a screen for searching the electronic mail with the state of "unread" on said display [A list of unread/already read messages is displayed on list pane 50 col. 3, lines 60 to col. 4, lines 7 and col. 4, lines 33-56. See fig. 3 and col. 5, lines 1-54].

As per claims 12 and 19, these claims have similar limitations as claim 5 above. Therefore, they are rejected with the same rationale. See the rejection of Claim 5 above.

As per claim 13 and 20, Bailey et al teach the invention, wherein the predetermined timing is a time point of which reading the body of the electronic mail is requested [col. 4, lines 24-65].

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 7, 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al USPN (5835084) in view of Kudoh et al USPN (5948058).

As per claims 7, 14 and 21, although Bailey et al shows substantial features of the claimed invention including a message window with icon buttons enabling a user to store, reply, forward and print message, he does not explicitly show deleting message list on the basis of a request for an end (end command) for reading an electronic mail. Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Bailey et al, as evidenced by Kudoh et al USPN (5948058).

In analogous art, Kudoh et al whose invention is about a system for cataloging and displaying emails, disclose deleting a message list (category of a classified electronic mail) on the

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basis of a request for an end of reading the electronic mail by a user [Col. 28, lines 48 to col. 29, line 13]. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Bailey to support mechanism of deleting a list of electronic mails for the flexibility of displaying electronic messages on a desktop and the advantage of improving storage space.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114.

Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this

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action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Bargadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

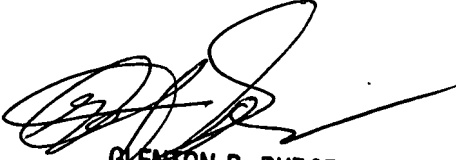
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

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